



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,435	11/13/2000	Robert Allan Unger	50P4199	7705

20480 7590 06/02/2005
STEVEN L. NICHOLS
RADER, FISHMAN & GRAVER PLLC
10653 S. RIVER FRONT PARKWAY
SUITE 150
SOUTH JORDAN, UT 84095

EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2616

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,435

Applicant(s)

UNGER, ROBERT ALLAN

Examiner

HUY T. NGUYEN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46, 48-58 and 60-63 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 23-29, 36-41, 51, 55, and 60-63 is/are allowed.
6) ☒ Claim(s) 1-22, 30-35, 42-50, 52-54 and 56-58 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 30, 31, 35, 37, 40, 52 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Pierre et al (6,678,463).

Regarding claims 30, 52 and 56, Pierre discloses a personal video recorder (Figs. 4-6, column 6) having a user-controlled data capture function, the recorder comprising: an input (102) for receiving an audiovisual signal and an output for outputting said audiovisual signal; a buffer (90,92) for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder (column 5, lines 10-15); a data storage unit (105); and a processor (10) that receives input from a user input device; wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising: a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and a second predetermined amount of said portion of

Art Unit: 2616

said audiovisual signal output by said recorder after receipt of said user command (column 6, lines 23-36 and 60-68). Pierre further teaches processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65).

Regarding claim 31, Pierre further teaches processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65).

Further for claims 35 and 40, Pierre further teaches that the predetermined first portion and second portion amount is set by the user input device since after storing the first predetermined amount in buffer, the user inputs command to input device to record the second predetermined amount corresponding to the remaining portion of the program until stopping recording (column 6, lines 5-20).

Regarding claim 37, Pierre teaches the use of a remote control device (column 4, lines 45-50).

3. Claims 42, 47, 48, 49 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Pierre et al (6,678,463).

Regarding claims 42 and 53, Pierre discloses a personal video recorder (Figs. 4-6, column 6) having a user-controlled data capture function, the recorder comprising: an input (102) for receiving an audiovisual signal and an output for outputting said audiovisual signal; a buffer (90,92) for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said

Art Unit: 2616

recorder (column 5, lines 10-15) ; a data storage unit (105) ; and a processor (10) that receives input from a user input device; wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising: a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command (column 6, lines 23-36, 60-68).

Further for 42 ,49 and 53 Pierre further teaches that the predetermined first portion and second portion amount is set by the user input device since after storing the first predetermined amount in buffer , the user inputs command to input device to record the second predetermine amount corresponding to the remaining portion of the program until stopping recording (column 6, lines 5-20).

Further for claims 42, 47, and 53, Pierre teaches the use of a remote control device (column 4, lines 45-50) and remote control device having a button (column 8, lines 1-10) for recording the segment and automatically stopping recording having captured segment (Fig. 7).

Regarding claim 48 , Pierre further teaches processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65) .

Applicant argues that Pierre fails to teach a dedicated button . In response, the examiner disagrees . It is noted that at column 4, lines 45-50, column 8, lines 1-10

Art Unit: 2616

Pierre teaches a button for actuating recording the segment and for automatically stopping recording having captured segment .

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made:

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 32,33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Kuroda (6,311,011).

Regarding claims 32 and 34 ,Pierre fails to teaches that the label including date stamp and time elapsed for the program . Kuroda teaches a recording apparatus

Art Unit: 2616

having a control means for labeling the recorded program with date stamp and time elapses for the program (column 7, lines 50-65)

It would have been obvious to one of ordinary skill in the art to modify Pierre with Kuroda by labeling the recorded program with date stamp and time elapsed information as additional information to identifying the recorded program to be reproduced .

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Inoue et al (5,990,881).

Regarding claim 33, Pierre fails to teaches adding time elapsed amount to the video-audio signal . Inoue teaches a recording /reproducing apparatus for recording video audio signal having means for adding time elapsed in the video signal (column 5, lines 35-45).

It would have been obvious to one of ordinary skill in the art to modify Pierre with Inoue by adding the elapsed time to the video audio signal of Pierre thereby for easily controlling the running time of the program.

7. Claims 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Kuroda (6,311,011).

Regarding claim 26, 29, 36 and 41, Pierre fails teaches the use of hard disk for storing the segment from the storage . However, it is noted that using a heard disk for storing the signal is well known in the art as taught by Kuroda. Therefore, it would have been obvious to one of ordinary skill in the art to modify Pierre by providing the

Art Unit: 2616

apparatus of Pierre with a disk driver for receiving a hard disk and storing the segment from the storage device for later user.

8. Claim 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Vallone et al (6,642,939).

Regarding claims 38 and 39, Pierre fails to specifically teach the use of a plurality of remote control units. Vallone teaches using a plurality of remote control devices for different user to control a system for accessing the video signal to be stored and replay (column 16, lines 60 to column 17, lines 25). It would have been obvious to one of ordinary skill in the art to modify Pierre with Vallone by using the teaching of Vallone for modifying the recorder and remote control of Pierre to provide a plurality remote control devices for controlling to recorder to record the program and accessing the recorded files by different users thereby enhancing the capacity of apparatus of Pierre for used with a plurality of users.

9. Claims 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al (6,678,463) in view of Lang (4,963,995).

Regarding claims 57 and 58, Pierre discloses a personal video recorder (Figs. 4-6, column 6) having a user-controlled data capture function, the recorder comprising: an input (102) for receiving an audiovisual signal and an output for outputting said audiovisual signal; a buffer (90,92) for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been

Art Unit: 2616

output by said recorder (column 5, lines 10-15) ; a data storage unit (105) ; and a processor (10) that receives input from a user input device; wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising: a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command (column 6, lines 23-36 and 60-68).

Further for claims 57 and 58, Pierre further teaches that the first predetermined amount of the first portion and second predetermined amount of the second portion are set by the user input device since after storing the first predetermined amount in the buffer, the user inputs a command to the input device to record the second predetermine amount corresponding to the remaining portion of the program or until stopping recording command is input by the user (column 6, lines 5-20).

Pierre fails to teach that the apparatus further comprises a reproducing means for playing back the stored video signal from a medium.

Lang teaches a recorder (Fig. 2) having recording means and reproducing means for recording and reproducing the video signal from a medium and for recoding the played back video signal (reproduced video signal) (column 9). It would have been obvious to one of ordinary skill in the art to modify Pierre with Lang by using the teaching of Lang for incorporating in the recording apparatus of Pierre with means for recording a video signal on a medium, reproducing (playing back) the

Art Unit: 2616

video signal and recording the played back video signal thereby enhancing the apparatus of Pierre for recording of segment comprising a first predetermined amount and a second predetermined amount of the played back video signal instead of a broad video signal .

10. Claim 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Kuroda (6,311,011).

Regarding claim 50, Pierre fails teaches the use of hard disk s for storing the segment from the storage . However, it is noted that using a heard disk for storing the signal is well known in the art as taught by Kuroda. Therefore, it would have been obvious to one of ordinary skill in the art to modify Pierre by providing the apparatus of Pierre with a disk driver for receiving a hard disk and storing the segment from the storage device for later user.

11. Claims 45-46,48-49 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Vallone et al (6,642,939).

Regarding claims 45-46, 48-49 and 54 , Pierre fails to specifically teach the use of a plurality of remote control units . Vallone teaches using a plurality of remote control devices for different user to control a system for accessing the video signal to be stored and replay (column 16, lines 60 t column 17, lines 25). It would have bee obvious to one of ordinary skill in the art to modify Pierre with Vallone by using the

Art Unit: 2616

teaching of Vallone for modifying the recorder and remote control of Pierre to provide a plurality remote control devices for controlling to recorder to record the program and accessing the recorded files by different users thereby enhancing the capacity of apparatus of Pierre for used with a plurality of users.

Further for claims 45-46, Pierre as modified with Vallone further teaches the secondary remote control has less function than the main remote control device (column 17, line 15-20).

12. Claims 1, 2-3,5, 9,11-13,17-18,11-13,15,21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Lynch et al (5,438,423).

Regarding, claims 1,11 and 17, Pierre discloses a personal video recorder (Figs. 4-6, column 6,) having a user-controlled data capture function, the recorder comprising: an input (102) for receiving an audiovisual signal and an output for outputting said audiovisual signal; a buffer (90,92) for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder (column 5, lines 10-15); a data storage unit (105); and a processor (10) that receives input from a user input device; wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising: a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and a second predetermined amount of said portion of

Art Unit: 2616

said audiovisual signal output by said recorder after receipt of said user command (column 6, lines 23-36, 60-68.

Pierre fails to teach that the first predetermined amount is less than the second predetermined amount.

Lynch teaches a recorder (the figure) having a buffer means having a dynamic buffer for storing all the received video signal and a static buffer (22) for storing a portion video signal less than the all portion retained in the buffer means, and a portion of video less than the video signal retained in the static buffer is transferred to a storage means for recording thereon (column 3).

It would have been obvious to one of ordinary skill in the art to modify Pierre with Lynch by using a static buffer for storing a portion of video signal less than all audio/video retained in the dynamic buffer and a control means as taught by Lynch for transferring a portion of the retained video signal in the buffer thereby enhancing the recorder of Pierre for enable of selecting a desired portion of the video signal retained in the buffer means for storing with the second predetermine amount.

Applicant argues that Pierre as modified with Lynch fails to teach storing video/audio signal less than all video/audio retained in the buffer. In response, the examiner disagrees. It is noted that the combination of Pierre and Lynch will teach the storing of video/audio signal portion that less than all audio/video signal retained in the buffer by transferring the audio/video signal as the first predetermine amount from the static buffer to the storage unit of Pierre to be recorded with the second predetermined amount.

Regarding claims 2, 3, 12,13, 18, Pierre further teaches the processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit (column 5, lines 5-65).

Regarding claims 5, 19, Pierre teaches the use of a remote control device (column 4, lines 45-50).

Regarding claims 15 and 21, Pierre as modified with Lynch further teaches that the predetermined first portion and second portion amount is set by the user input device since after storing the first predetermined amount in buffer, the user inputs command to input device to record the second predetermine amount corresponding to the remaining portion of the program until stopping recording (column 6, lines 5-20).

Regarding claim 22, Pierre as modified with Lynch further teaches transferring n the segment from the recorder for viewing by a monitor.

13. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Lynch as applied to claim 1 above further in view of Kuroda (6,311,011).

Regarding claims 4 and 10, Pierre fails to teach the use of hard disk s for storing the segment from the storage. However, it is noted that using a heard disk for storing the signal is well known in the art as taught by Kuroda. Therefore, it would have been obvious to one of ordinary skill in the art to modify Pierre with Kuroda by providing the apparatus of Pierre with a disk driver for receiving a hard disk and storing the segment from the storage device for later user.

14. Claims 6,7,14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre in view of Lynch as applied to claims 1,5, 11 and 19 above, further in view of Val lone et al (6,642,939).

Regarding claims 6,7,14 and 20, Pierre fails to specifically teach the use of a plurality of remote control units. Vallone teaches using a plurality of remote control devices for different user to control a system for accessing the video signal to be stored and replay (column 16, lines 60 t column 17, lines 25). It would have bee obvious to one of ordinary skill in the art to modify Pierre with Vallone by using the teaching of Vallone for modifying the recorder and remote control of Pierre to provide a plurality remote control devices for controlling to recorder to record the program and accessing the recorded files by different users thereby enhancing the capacity of apparatus of Pierre for used with a plurality of users.

15. Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierre et al in view of Lynch as applied to claims 1 and 11 above, further n view of JO (5,237,462).

Regarding claim 9 and 16, Pierre fails to teach the second predetermined amount is determined by length of time.

Jo teaches a recording apparatus having a control means for setting a length of time for a predetermined amount of video signal (Abstract).

It would have been obvious to one of ordinary sill in the art to modify Pierre with JO by using a control means as taught by JO with the apparatus of Pierre for setting the

Art Unit: 2616

second predetermine amount by a length of time thereby accurately controlling the second predetermined amount to be recorded.

Allowable Subject Matter

16. Claims 23-29,36-41,51,55 and 60-63 are allowed.

Response to Arguments

17. Applicant's arguments filed 07 January 2005 have been fully considered but they are not persuasive.

Applicant argues that Pierre does not teach using information for identifying the segment . In response, the examiner disagrees . It is noted that Pierre teaches that a program that is comprises a first portion and second portion is stored as a file and each file having a unique identifying information used for retrieving the file (column 5, lines 55-65). Pierre further teaches that the segment (file) that comprises a first portion and second portion can be any part of a show and a movie program (column 4, lines 14-40) . It is clearly that Pierre teaches each segment (file) having a label that distinguishes from other taken from a movie program or a show. Since recording a segment that including a first amount and a second amount is controlled by the user, the user can operates the recorder to produce a plurality of segments in a program by repeatedly recording and stopping within the broadcast program .

Further Pierre teaches generating ID for each recorded generated segment . It is clear that Pierre teaches generating a segment (a single program or a plurality of segment of a broadcast program and each segment having an ID .

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

Art Unit: 2616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY NGUYEN
PRIMARY EXAMINER